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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,005	09/22/2003	Matthias Krull	2000DE402/D	1909

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CLARIANT CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
4000 MONROE ROAD  
CHARLOTTE, NC 28205

EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/668,005

**Applicant(s)**

KRULL ET AL.

**Examiner**

Cephia D. Toomer

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/760,319.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-9 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,652,610.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because the additive set forth in the present claims is the additive that is used in the method of the patent.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected because there is no antecedent support with the claim for R<sup>3</sup> because NR<sup>3</sup> has been deleted.

Claim 5 is rejected because claim 1 does not provide proper antecedent support for the nitrogen containing compounds.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4, 6, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 19738271 with US 6,010,989 as the English translation and EP 493769 (US 5,254,652) and DE 3142955 (US 4,431,565) as evidentiary references.

DE '271 teaches an additive for improving the flow properties of paraffin-containing mineral oils and mineral oil distillates comprising a mixture of at least one ethylene/vinyl ester terpolymer, at least one paraffin dispersant and an ester derived from monobasic carboxylic acids having 4 to 30 carbon atoms and polyhydric alcohols having 1 to 30 carbon atoms (see abstract).

The terpolymer comprises 65-94 mol% ethylene, 5-35 mol% of vinyl acetate and 1-25 mol% of a neocarboxylic acid containing 9-19 carbon atoms (see col. 4, lines 12-25). DE '271 teaches that such compounds are disclosed in EP 493769. EP '769 teaches that the melt viscosity of the terpolymers is 200-1000 mPas (see US 5,254,652; col. 2, lines 64-68).

DE '271 also teaches that up to 30% by weight of alkylphenol-aldehyde resins, such as those described in DE 3142955 may be included in the additive composition (see US 6,010,989; col. 3, lines 11-13; col. 6, lines 27-30). DE 3142955 teaches alkylphenol-aldehyde resins as set forth in claim 11 of the present invention. DE'271 teaches that the terpolymer and paraffin dispersant are present in a ration of 1:10 to 10:1 (see col. 5, lines 29-35).

Accordingly, DE 19739271 teaching all the limitations of the claims anticipates the claims.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 6, 7, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 2,242,474 in view of EP 680 506.

CA teaches a flow improver composition for mineral oils comprising a terpolymer of 65 to 94 mol% ethylene, 1-25 mol% of a neocarboxylic acid and 5-35 mol% vinyl acetate (see abstract and claim 1). The terpolymer has a melt viscosity at 140 C of from 20 to 10000 mPas (see page 7, lines 28-29). The mineral oil may be gas oil, diesel oil or heating oil (see page 1, lines 10-25).

CA teaches that the flow improver composition may contain a paraffin dispersant, a comb polymer, such as fumarate vinyl acetate copolymers (see page 9, lines 24-31). The mixing ratio of the terpolymer to comb polymer is 1:10 to 20:1 (see page 10, lines 5-6). CA teaches that conventional additives may be included in the flow improver composition. Such additives include lubricity enhancers. CA teaches the limitations of the claims other than the oil-soluble amphiphile. However, EP 680506 teaches this difference.

EP 680506 teaches a fuel oil composition comprising a lubricity additive (see page 2, lines 3-4). The lubricity additive comprises an ester of a carboxylic acid and an alcohol wherein the acid has from 2-50 carbon atoms and the alcohol has one or more carbon atoms (see page 2, lines 36-39). An example of the additive includes glycerol monooleate (see page 4, line 55). EP 680506 teaches that middle distillate cold flow improvers may be included in its fuel (see page 4, lines 43-46).

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It would have been obvious to one of ordinary skill in the art to include the lubricity additive in the fuel oil composition because CA especially desires a lubricity additive and the additive would perform its attendant function.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over CA 2242474 in view of EP 680506 as applied to claims above, and further in view of Davies (US 6,010,545).


CA and DE have been discussed above. The references fail to teach that the lubricity additive is a fatty acid. However, Davies teaches that esters such as those disclosed in EP 680 506 may be replaced with one or more carboxylic acids (see col. 6, lines 18-21; col. 5, lines 42-55).

It would have been obvious to one of ordinary skill in the art to include fatty acid lubricity additives because Davies teaches that they are art recognized equivalents of the esters of these fatty acids.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

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